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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,422	07/11/2003	Hideshi Morii	9871/0N052US0	7086
7278	7590	08/02/2006	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			FENSTERMACHER, DAVID MORGAN	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/618,422	MORII ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David M. Fenstermacher	3682	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's arguments, see amendment/remarks, filed 6/30/06, with respect to the rejection(s) of claim(s) 1-2 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Freese V (6,058,898) under 35 USC 103(a).
2. This action is NOT final.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freese V (6,058,898).

Freese shows the claimed invention where an oil pan structure has a swelled portion (as at 44) which provides cooling to the engine oil via a heat exchanger (64, 66, 68)., the oil is cooled via engine coolant through passages (74), the swelled portion also having a removable cover (72), the oil pick-up passage may employ a strainer. the body 24 also includes an oil pick up passage 52 formed integrally therewith and providing fluid communication between the reservoir 26 and the engine 10 through the

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flanged lip 38. The pick up passage 52 has an inlet 54 formed in the bottom 28 of the reservoir 26 and at least one outlet 56 formed in the flanged lip 38 of the body 24. A strainer may also be employed at the inlet 54 to the pick up passage 52 to further filter the oil flowing through the lubrication system of the engine 10.

But Freese does not show the cover on the bottom of the oil pan.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the cover of Freese on the bottom of the oil pan since the mere relocation of the cover would be well within the skill in the art and would increase the air flow across the cover which would aid in cooling.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

However, since the same art was applied, but under a different section of the statute, Applicant's arguments will be addressed. Applicant argues three points, as follows:

*Amended claim 1 recites a swelled portion formed on a bottom portion of the oil pan by swelling the bottom portion to a side opposite to the crankcase." In contrast, the swelled portion of Freese referenced by the Examiner is not opposite the crankcase.*

The crankcase holds the crankshaft. The crank is opposite the side of the pan inasmuch as it is opposite the bottom.

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*Amended claim 1 also recites "a cover member provided on the swelled portion for covering a lower face of the bottom portion." The cover member of Freese covers a side of the oil pan not a lower face.*

The rejection has been amended to correct this oversight. Although, one may argue that the bottom of the pan could very well be on the side since the top of the pan is where it attached to the lower portion of the block.

*Amended claim 1 also recites "an oil passage formed from the cover member and the bottom portion." This feature is not disclosed by Freese. Further, the cover member of Freese is slotted (column 4, line 54) and can not function as part of an effective oil passage.*

It is the Examiner's position that if oil passes through it, it is a passage, slotted or not.

### ***Allowable Subject Matter***

6. Claim3 is allowed.

### ***Conclusion***

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

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and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Fenstermacher whose telephone number is 571-272-7102. The examiner can normally be reached on 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
David M. Fenstermacher  
Primary Examiner  
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